

REMARKS

Claims 1-20 are pending in this application. Claims 16-20 are presently withdrawn from consideration. By this Amendment, claims 1-6, 8 and 9 are amended. Claim 1 is amended to overcome the claim rejection under 35 U.S.C. §112. Claims 2-6, 8, 9 and 16 are amended to correct antecedent basis.

No new matter is added by this Amendment. Support for the language added to claims 1-6, 8 and 9 can be found in the specification at, for example, paragraph [0053].

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Kuhns in the October 22, 2007 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because the amendments are made in response to arguments raised in the final rejection.

Entry of the amendments is thus respectfully requested.

I. Rejection Under 35 U.S.C. §112

Claims 1-15 were rejected under 35 U.S.C. §112, first paragraph, as allegedly being non-enabled by the specification. Specifically, the Patent Office alleges that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with the present claims. The Patent Office further points out that specific guidance as to solvent selection is provided at page 11 of the present specification. This rejection is respectfully traversed.

A. Starting Polymer

In the Office Action, the Patent Office alleges that Applicants argument that one of ordinary skill in the art of membrane development does not start with any polymer-solvent combination, but starts with a particular polymer, such as a particular polyolefin, is not persuasive because the claim language at issue requires the selection of a polymer-solvent combination.

In response to the Patent Office's allegation, claim 1 is amended to replace the phrase "polymer component" with the phrase "at least one polyolefin." Amended claim 1 recites a particular polymer, the at least one polyolefin, such that selection of the solvent to use with the particular polymer does not require undue experimentation to practice the subject matter of claim 1. Thus, Applicants respectfully submit that the selection of a solvent and the at least one polyolefin combination satisfying the last clause of claim 1 is enabled by the specification and does not require undue experimentation.

Applicants submit that amended claim 1 requires a particular starting polymer, the at least one polyolefin, as requested by the Patent Office.

B. Applicable Solvent

In the Office Action, the Patent Office suggests that the relatively small number of applicable solvents be bundled into a Markush group and incorporated into claim 1.

In response to the suggestion by the Patent Office, Applicants submit that bundling the applicable solvents into a Markush group is not appropriate because some of the solvents may be applicable to a first polyolefin and not applicable to a second polyolefin while other solvents may be applicable to a second polyolefin and not applicable to a first polyolefin.

Applicants submit that the specification and claims give much guidance on how to select the appropriate solvent(s) to use with the at least one polyolefin without undue experimentation. According to feature a) of amended claim 1, one of ordinary skill in the art

of membrane development selects an appropriate solvent for the at least one polyolefin to form a system appropriate for such process, wherein the system at elevated temperatures has a range in which it is present as a homogeneous solution, on cooling has a critical demixing temperature, below the critical demixing temperature in the liquid state of aggregation has a miscibility gap, and has a solidification temperature. Thus, one of ordinary skill in the art is provided with reasonable guidance by the specification and amended claim 1 with respect to conducting any needed experimentation to determine an appropriate solvent for the at least one polyolefin in accordance with feature a) of claim 1.

Thus, only solvents which fulfill the criterion of feature a) of claim 1 have to be tested according to the simple, routine test disclosed in the specification. The number of solvents that must be tested is therefore relatively small or minimal because of the requirement of also satisfying the criterion of feature a) of claim 1.

Applicants submit that when starting from the at least one polyolefin and depending on the desired application for the resulting membrane, it is absolutely routine work for one of ordinary skill in the art of membrane development to determine an appropriate solvent as set forth in feature a) of claim 1. Additionally, paragraph [0054] of the present application provides specific guidance on selection of the appropriate solvent to use with the at least one polyolefin. Specifically, paragraph [0054] of the present application sets forth that the appropriate solvents to be used with (1) a first polyolefin such as polypropylene include N,N-bis(2-hydroxyethyl)tallow amine, dioctyl phthalate, or a mixture thereof are preferably used as solvents and (2) a second polyolefin such as poly(4-methyl-1-pentene) include palm nut oil, dibutyl phthalate, dioctyl phthalate, dibenzyl ether, coconut oil, or a mixture thereof.

C. Conclusion

Applicants submit that amended claim 1 is enabled such that one of ordinary skill in the art would be able to make the invention commensurate in scope with the present claims

without undue experimentation because a particular starting polymer, the at least one polyolefin is recited in claim 1. Additionally, Applicants submit that the present specification contains a written description (see paragraph [0054] of the present specification) of the subject matter of claim 1 that is full, clear, concise and in exact terms such that one of ordinary skill in the art would be able to make and use the claimed subject matter without undue experimentation. Moreover, Applicants submit that claim 1 is described in the present specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

For at least the foregoing reasons, claims 1-15 are enabled. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

II. Rejoinder

Applicants respectfully submit that because claims 1-15 are in condition for allowance for the reasons set forth above, claims 16-20 should be rejoined and similarly allowed as all withdrawn claims depend, directly or indirectly, from claim 1. Thus, withdrawal of the Restriction Requirement and rejoinder of claims 16-20 are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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